

REMARKS

Claims 1-15 are pending in the application. No claims have been amended. Applicants respectfully request reconsideration in light of the following remarks.

1. Rejection of claims 1-15 under 35 U.S.C. §103(a) as obvious over Wiemann et al., U.S. Patent No. 6,093,497, hereafter "Wiemann" in view of Bergfried et al., Canadian Patent Publication No. 2,154,818 A1, hereafter "Bergfried".

In making the rejection the PTO has asserted that it would have been obvious to one of ordinary skill in the art at the time of invention by Applicants to use the surfactant of Bergfried in the basecoat composition of Weimann to make an aqueous pigment paste as claimed.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a *prima facie* case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

The instant basis of rejection fails to meet this standard. In particular, the cited combination of Wiemann and Bergfried fails to disclose or suggest all of the required elements of the aqueous pigment paste of independent claim 1.

Applicants respectfully assert that the limitation "from 15 to 40% by weight of at least one metal pigment" is not taught nor suggested by the combination of Wiemann and Bergfried. Applicants respectfully submit that independent claim 1 recites "from 15 to 40% by weight of at least one metal pigment", and "at least 50% by weight of water", "based on total weight". On the other hand, Wiemann teaches that the proportion of pigments and fillers may amount in total to from 5 to 25% by weight, based on the solids content (Wiemann, column 4, lines 60-63.) Since Applicants' claim recites at least 50% water, and the weight percent recited for the pigment is for total weight, then based on solids content alone, the metal pigment would be present in 30% or more by weight, which is larger than and outside of the weight range of 5 to 25% by weight taught by Wiemann.

Bergfried teaches 40 - 60% of an electrically conductive pigment based on metal oxides. However, Applicants disclose that "by metal pigments are meant finely divided metallic pigments, usually in the form of flakes, which are commercialized as powders or pigment pastes. A distinction is made between metallic pigments and those metal effect pigments which fulfill functional roles, e.g., in corrosion protection, as conductive pigments, or for protecting against electromagnetic radiation" (emphasis added, Application as filed, paragraph bridging pages 8 and 9.) Thus, Bergfried's electrically conductive pigment based on metal oxides does not read on Applicants' metallic pigments. In addition Bergfried teaches 2 - 4.9 % of a terpolymeric polyacrylate (Bergfried, claim 1,) which is a binder, while Applicants' claim 1 recites that the aqueous pigment paste is free from binders and grinding resins, placing Bergfried outside the scope of Applicants' claims.

For at least this reason, Applicants respectfully assert that the instant claims are patentable over the combination of Wiemann and Bergfried because the combination of Wiemann and Bergfried fails to teach or suggest all the elements of independent claim 1. Withdrawal of the rejection is respectfully requested.

Further, Applicants maintain their arguments filed on 21 February 2007. The Examiner states that "Wiemann et al. disclose that their coating composition may utilize binders. Therefore, the use of binder is optional as explained in the grounds of rejection above" (5/3/2007 Office Action, page 2, final paragraph.) Applicants respectfully disagree and respectfully submit that component (x) taught by Wiemann reads on "binder", and is a required element in Wiemann's composition. This is affirmed by the language "auxiliary binder" used in Wiemann, inferring that there is present a main binder, which is component (x). Thus, component (x) is a required binder, whereas "auxiliary binder" is an optional binder in addition to the required binder, component (x).

Accordingly, reconsideration and removal of the obviousness rejection of claims 1-15 is respectfully requested in view of the foregoing remarks.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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